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IN THE

Supreme Court of the United States

October Term, 1941.

No. 1130. 71

UNITED CARBON COMPANY and UNITED CARBON COMPANY, INC.,

Petitioners,

v.

BINNEY & SMITH COMPANY,

Respondent.

REPLY BRIEF OF PETITIONERS.

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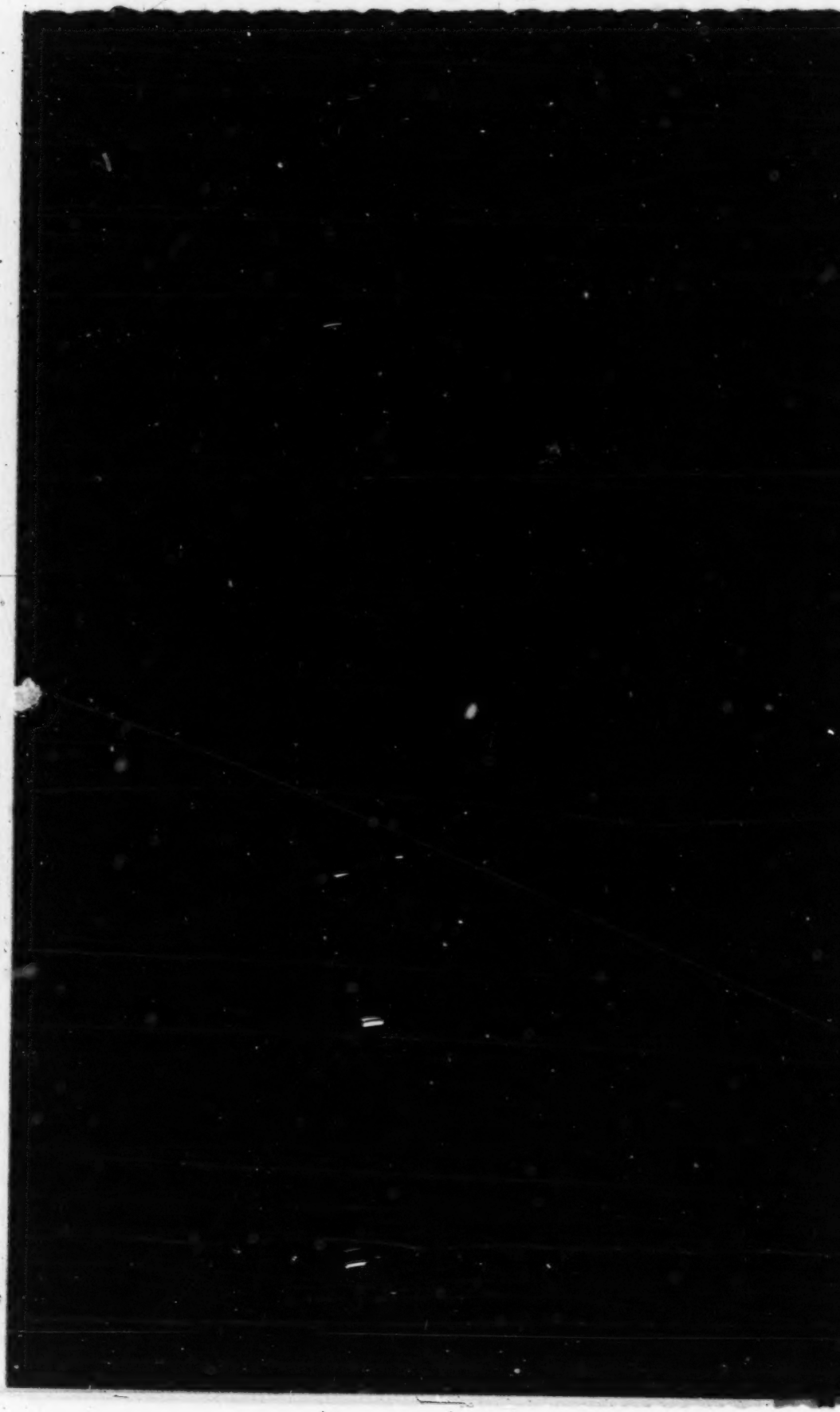

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(1) The first issue *of law* that arises upon the present record is whether want of novelty and invention in the claims here in issue is not established by the prior art patents, particularly No. 1,286,025 (R. 309) to Knowlton & Hoffman.

If the Court is able from mere comparison to say what is the invention described in each and to affirm from such mere comparison that products there described are the same, then the question of identity is a matter *of law* for the Court.

In *Market Street Railway Co. v. Rowley*, 155 U. S. 621, 625, this Court said:

> "If, upon the state of the art as shown to exist by the prior patents, and upon a comparison of the older devices with those described in the patent in suit, it should appear that the patented claims are not novel, it becomes the duty of the court to so instruct the jury.

> Powder Co. v. Powder Works, 98 U. S. 126; Heald v. Rice, 104 U. S. 737, 749; Fond duLac County v. May, 137 U. S. 395."

The same principle was applied with respect to the issue of infringement in *Singer Co. v. Cramer,* 192 U. S. 265, 275, and in *Sanitary Refrigerator Co. v. Winters,* 280 U. S. 30, 36.

In *Heald v. Rice,* 104 U. S. 737, 749, the question of identity of invention in the original and the reissued patents, was determined from their face as a matter of law.

Petitioners contend that the product of Knowlton & Hoffman is the identical product of the claims in suit, and that this appears from an examination and comparison of the two patents.

A further issue *of law* arises, but under like principles, in determining whether the claims in issue are not invalidated by reason of the claims cancelled or rejected during the pendency of the application for the patent in suit. That issue of law should be determined in the light of the true principle stated by this Court in *Schriber Co. v. Cleveland Trust Co.,* 311 U. S. 211, 221, thus:

> "The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. See Leggett v. Avery, 101 U. S. 256, 259.
>
> "True, the rule is most frequently invoked when the original and cancelled claim is broader than that allowed, but the rule and the reason for it are the same if the cancelled or rejected claim be narrower."

Petitioner contends that the Court of Appeals not only stated the applicable rule inaccurately, but so construed

the claims in issue as to make them identical with the cancelled and rejected claims.

(2) Respondent opposes the grant of the petition because it says that a conflict on issues of fact may arise at some later date. It is true that respondent has just brought suit for infringement in Massachusetts, but this was only after a suit for declaratory judgment was instituted against it in New Jersey. There is little probability that either of those cases will be decided by a Court of Appeals within the present or even the next year. In the meantime respondent can continue to exercise its monopolistic control of the carbon black industry and its incidental control of the tire and rubber industry by the patent in suit. It is to be anticipated that respondent will use every means in its power —by interlocutory motions and appeals—to postpone a review by this Court, while it enjoys the fruits of its presently existing monopoly.

(3) We respectfully submit that a decision by this Court on the question whether or not the Respondent is legally entitled to a monopoly of the carbon black in pellet form and, through it, of the tire and rubber industry, should not await the time-consuming process of carrying another case to a court of appeals, while the respondent continues to exercise its monopoly over carbon black in pellet form. Our country is at war; the rubber situation is more than critical. Here are the "exceptional circumstances" which urgently press for immediate action instead of the usual procedure when only interests of the parties are involved.

The supervisory jurisdiction of this Court by certiorari, "coextensive with all possible necessities", was

adopted to give flexibility to our judicial system so that critical situations may be dealt with when they arise.

Respectfully submitted,

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OSMAN E. SWARTZ,
Of Counsel.

May 7, 1942.